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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,767	07/06/2004	Johan George Kloosterboer	NL 020031	7140

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EXAMINER	
MCCLENDON, SANZA L	
ART UNIT	**PAPER NUMBER**
1711	

DATE MAILED: 09/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/500,767	KLOOSTERBOER ET AL.	
	Examiner	Art Unit	
	Sanza L. McClendon	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 July 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112: The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 3-4 and 11-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Regarding claims 3-4 and 11-12, the phrase "formed by" renders the claim indefinite because it is unclear what applicant is intending. Is applicant intending for these compounds to be reaction products, i.e., form using one of the listed compounds? If so, then the reaction product with what? Is applicant intending for these claims to have Markush language, i.e., selected from the group consisting of, or selected from the groups consisting essentially of? Is applicant intending for the reactive diluents to "comprise" the listed compounds? Clarification is requested.

Conclusion

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of copending Application No. 09/932,071. Although the conflicting claims are not identical, they are not patentably distinct from each other because they appear to comprise overlapping subject matter. The primary difference between the applications is the limitation "which only shows signs of gelation when at least 50% of the conversion that can be achieved in the mold under relevant curing conditions has taken place" in 09/932,071 vs. the "at least 30%" in the instant application. The examiner deems these overlap, since "at least 50%" conversion of 09/932,071 is included in the upper limits of the "at least 30%" instantly claimed. Therefore it would have been obvious for an artisan of ordinary skill in the art to obtained said replica and/or manufacture a replica according to the instant invention from the teachings of 09/932,071 in the absence of evidence to the contrary and/or unexpected results.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 1-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 2002/0033547. Although the conflicting claims are not identical, they are not patentably distinct from each other because they appear to comprise overlapping subject matter. The primary difference between the applications is the limitation "which only shows signs of gelation when at least 50% of the conversion that can be achieved in the mold under relevant curing conditions has taken place" in 2002/0033547 vs. the "at least 30%" in the instant application. The examiner deems these overlap, since "at least 50%" conversion of 2002/0033547 is included in the upper limits of the "at least 30%" instantly claimed. Therefore it would have been obvious for an artisan of ordinary skill in the art to obtained said replica and/or manufacture a replica according to the

instant invention from the teachings of 2002/0033547in the absence of evidence to the contrary and/or unexpected results.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

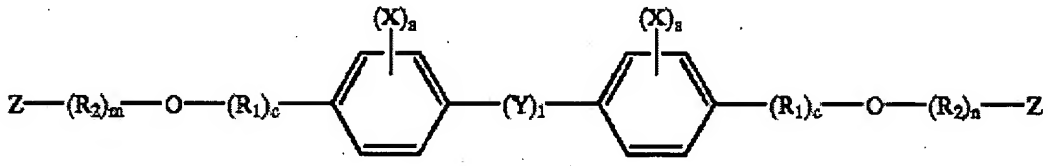
7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Kloosterboer et al (2002/0033547).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Kloosterboer et al teaches a method of manufacturing a replica and a replica obtained therefrom. Said method includes curing a cationic photopolymerizable resin composition between a mold and a substrate, wherein said resin composition shows signs of gelation when at least 50% of the conversion is achieved when curing said mold. Said resin composition comprises a compound having the general formula:



,wherein the definitions can be found on page 2. These appear to anticipate the compounds of claims 3-4 and 10-11--see [0020]. In addition to the above compound said resin composition can comprise a reactive diluent. Said reactive diluent comprises compounds found on page 2 in [0021]. These appear to anticipate claims 2, 5 and 12. Said composition is suitable for making replicas requiring accurate (sub-micron) reproduction, such as those found in [0023]. These anticipate claims 7-9. The examiner deems that the replica obtained from said composition disclosed by Kloosterboer et al having at least 50% of the conversion is achieved when curing said mold anticipates the claimed invention (claims 1 and 6).

9. Claims 1-2 and 6-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Herbrechtsmeier (WO 98/42497).

Herbrechtsmeier et al teaches molding processes comprising the steps:

(a) dispensing prepolymer material into a female mold half;

(b) mating a male mold half to the female mold half;

(c) applying radiation to crosslink and/or polymerize the prepolymer material to form a molding;

(d) separating the male mold half from the female mold half;

(e) washing the molding to remove unreacted prepolymer;

(f) ensuring the molding is adjacent a selected mold half;

(g) grasping the molding in a central area to remove the molding from the selected mold half;

(h) depositing an acceptable molding into packaging;

(i) cleaning the male and female mold halves; and

(j) indexing the male and female mold halves to a position for dispensing prepolymer.

Said prepolymer material comprises a prepolymer, wherein said prepolymer can have crosslinkable cationic groups—see page 36. Said prepolymer can be included with a vinylic comonomer—see page 34. Said molding process according to Herbrechtsmeier et al can be used to make contact lens materials. The inventions of claims 1-2 and 6-9 are anticipated by the reference.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanza L. McClendon whose telephone number is (571) 272-1074. The examiner can normally be reached on Monday through Friday 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The

fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sanza L McClendon 9/19/05

Sanza L McClendon
Examiner
Art Unit 1711

SMc